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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,413	11/21/2001	Nancy Allbritton	CAL01-005-US	6314
43320	7590	10/23/2006	EXAMINER	
EVAN LAW GROUP LLC 600 WEST JACKSON BLVD., SUITE 625 CHICAGO, IL 60661			BRUSCA, JOHN S	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,413

Applicant(s)

ALLBRITTON ET AL.

Examiner

John S. Brusca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-85 and 88-100 is/are pending in the application.
- 4a) Of the above claim(s) 83-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66,67,69,70,75-77,82,88-91,99 and 100 is/are rejected.
- 7) ☒ Claim(s) 68,71-74,78-81 and 92-98 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. It is brought to the applicant's attention that two terminal disclaimer papers were filed on 18 August 2006, but only one terminal disclaimer fee has been authorized to be charged by the applicants. The Office has chosen to arbitrarily approve one terminal disclaimer over U.S. Patent No. 6,335,201 as noted below in view of the single fee authorized by the applicants. In the future the applicants may list multiple patents or applicants on a single terminal disclaimer paper and pay a single fee for the single paper.

2. The terminal disclaimer filed on 18 August 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **U.S. Patent No. 6,335,201** has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The terminal disclaimer filed on 18 August 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **U.S. Patent No. 6,740,497** does not comply with 37 CFR 1.321(b) and/or (c) because:

The disclaimer fee of \$130.00 in accordance with 37 CFR 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card.

Consequently, the rejection under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,740,497 in the Office action mailed 12 May 2006 has been maintained as noted below.

Double Patenting and 35 USC 102(f)

4. The rejection of claims 66, 67, 69, 70, 75-77, 82, 88-91, 99, and 100 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 6, 9, and 12 of U.S. Patent No. 6,335,201 in the Office action mailed 12 May 2006 has been withdrawn in view of the terminal disclaimer filed 18 August 2006.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would be obvious

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over, the reference claim(s). see, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

7. Regarding use of the specification in obviousness-type double patenting rejections, the MPEP states in section 804:

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. In *re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In *re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized “that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim,” but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first “determine how much of the patent disclosure pertains to the invention claimed in the patent” because only “[t]his portion of the specification supports the patent claims and may be considered.” The court pointed out that “this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.”

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

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9. Claims 66, 67, 69, 70, 75-77, 82, 88-91, 99, and 100 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

10. Claims 3, 4, 6, 9, and 12 of U.S. Patent No. 6,335,201 and instant claims 66, 67, 69, 70, 75-77, 82, 88-91, 99, and 100 are not patentably distinct from each other because the claims of U.S. Patent No. 6,335,201 are generic with respect to the number of enzymes analyzed and U.S. Patent No. 6,335,201 provides guidance in column 7, lines 16-18 for simultaneous use of multiple reporter substrates. It would have been obvious to one of ordinary skill in the art at the time of filing of U.S. Patent No. 6,335,201 to use four or more substrates simultaneously in view of the above mentioned guidance to use multiple substrates simultaneously. Regarding instant claim 91, the cell of claim 3 of U.S. Patent No. 6,335,201 inherently comprises a portion of a cell.

For the reasons discussed above, it is apparent that U.S. Patent No. 6,335,201 contains claimed subject matter in claims 3, 4, 6, 9, and 12 that is not patentably distinct from instant claim 1. Because the inventive entity of U.S. Patent No. 6,335,201 is different from the instant application, a rejection is appropriate under 35 U.S.C. 102(f). This rejection could be overcome by amendment of the appropriate claims so that the claims are patentably distinct, or by filing a declaration signed by the inventors of the rejected claimed subject matter stating the inventive entity for the commonly claimed subject matter is identical.

11. Claims 66, 67, 69, 70, 75, 76, 82, 88-91, 99, and 100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 7, 17, and 18 of U.S. Patent No. 6,740,497. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent No. 6,740,497

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are drawn to oncoprotein species of substrate target and are generic with respect to the number of enzymes analyzed and U.S. Patent No. 6,740,497 provides guidance in column 8, lines 22-24 and claim 15 for simultaneous use of multiple reporter substrates. It would have been obvious to one of ordinary skill in the art at the time of filing of U.S. Patent No. 6,740,497 to use four or more substrates simultaneously in view of the above mentioned guidance to use multiple substrates simultaneously. It would have been obvious to one of ordinary skill in the art at the time of filing of U.S. Patent No. 6,740,497 to use four or more substrates simultaneously in view of the above mentioned guidance to use multiple substrates simultaneously. Regarding instant claim 91, the cell of claim 2 of U.S. Patent No. 6,740,497 inherently comprises a portion of a cell.

Allowable Subject Matter

12. Claims 68, 71-74, 78-81, and 92-98 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments filed 10 August 2006 have been fully considered but they are not persuasive. Regarding the rejection under 35 USC 102(f) the applicants point to MPEP 2137.

The relevant passage is reproduced below from MPEP 2137:

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f). However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f), or to rebut a rejection

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under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter invented by the applicant rather than derived from the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In re Katz, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship, and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the...inventor" of the subject matter disclosed in the article and claimed in the application).

It is noted that the cited reference, U.S. Patent No. 6,335,201 does claim subject matter not patentably distinct from the instant claims.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John S. Brusca 18 October 2006

John S. Brusca
Primary Examiner
Art Unit 1631

jsb